

REMARKS

As an initial matter, Applicants gratefully acknowledge the Examiner's statement that claims 23-28 are allowed (Office Action, May 8, 2003).

Claims 5 and 6 have been amended to correct the Markush language. The amendment is intended only to more particularly point out and distinctly claim the subject matter of the original claims, and not to limit the scope of the claims. In particular, deletion of the term "independently" from claims 5 and 6 is not intended to suggest that any of groups R^1 through R^4 are necessarily the same or different. In other words, groups R^1 , R^2 , R^3 , and R^4 remain independent of each other. This amendment adds no new matter.

The Rejection

Claims 5 and 6 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite for using improper Markush language.

Claims 1-5, 10, 15, 16, 19 and 20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,329,492 (the parent of this case).

Arguments

In the official Office Action dated May 8, 2003, the Examiner restricted prosecution of the application to a single invention and required that applicants elect one of the following groups for prosecution in this application:

I. Claims 1-6, 10, 15, 16, 19, 20 and 23-28, drawn to an aryleclopentylaryl polyepoxide of general formula (I) wherein the aryleclopentyl repeating unit quantified by "m" is zero as limited in claims 23-28, classified in class 549, subclass 522.

II. Claims 1-5, 10 and 15-22, drawn to an aryleclopentylaryl polyepoxide cooligomer of general formula (I) wherein the aryleclopentyl repeating unit quantified by "m" is a positive number as limited in claims 17, 18 and 21, classified in class 528, subclass 98.

III. Claims 7-9, 11 and 12, drawn to an aryleclopentylaryl polyepoxide and a curing agent, classified in class 525, subclass 481.

IV. Claim 13, drawn to a resin-encapsulated electronic device, classified in class 257, subclass 793.

V. Claim 14, drawn to an aryleclopentylaryl polyepoxide wherein the Ar² group of the aryleclopentyl repeating unit further comprises a phenolic moiety, classified in class 525, subclass 523.

Accordingly, in response to the Examiner's Action, applicants respectfully elect Group I, i.e., claims 1-6, 10, 15, 16, 19, 20 and 23-28, and particularly claim 24, with traverse. This same group was elected provisionally during a telephone conversation with the examiner on April 22, 2003.

However, it is believed that the invention of the respective claims is so similar that no burden would be put on the examiner by examining all together. The examiner has stated that "claims 1-28 are generic" (Office Action, dated May 8, 2003, page 4, last line). Therefore, once one generic claim is allowed, all of the other claims dependent on these claims must be allowed. The imposition of a restriction requirement would be wasteful of both the USPTO's and the applicants' resources, and unfairly burden the applicants. The requirement would require the USPTO to examine once again claims already examined, and would require the applicants to file another application for claims that should be examined together. For all of these reasons, the applicants request reconsideration of the restriction requirement.

Applicants respectfully request an expedited and timely response to applicants' request for reconsideration of the restriction requirement so that the applicants may promptly file a petition to withdraw the restriction requirement in accordance with 37 C.F.R. 1.144, in the event that the Examiner upholds the restriction requirement.

Regarding the rejection of claims 1-5, 10, 15, 16, 19, and 20 under the judicially-created doctrine of double patenting, applicants herewith submit a Terminal Disclaimer, disclaiming any portion of the term of the present application that would extend beyond the term of prior U.S. Patent No. 6,329,492.

Regarding the rejection of claims 5 and 6 for improper Markush language, the language has been corrected. Applicants believe that the claims now comply with 35 U.S.C. 112.

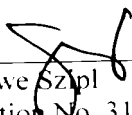
It is believed that claims 1-6, 10, 15, 16, 19, and 20 are now in condition for allowance, and prompt allowance of those claims is earnestly solicited. Furthermore, it is believed that the remaining claims are in condition for examination, and the Examiner's early and favorable

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consideration is earnestly solicited. Questions are welcomed by the below-signed attorney for applicants.

Respectfully submitted,

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